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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,362	03/21/2001	Ken Chow	17243CIP3(AP)	4078

7590

02/08/2002

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EXAMINER

HIGEL, FLOYD D

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 02/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. <u>09/815,362</u>	Applicant(s) <u>KEN CHOW ET AL</u>
Examiner <u>FLOYD D. HIGEL</u>	Group Art Unit <u>1636</u>

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on December 30, 2001
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 TO 108 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 TO 108 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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Claims 1 to 108 are rejected under 35 USC 112, second paragraph, for failing to properly define the invention. Since Markush terminology is not employed the expression, ~~all~~ all occurrences, "and all pharmacologically acceptable salts, esters, stereo isomers and ~~racemic~~ racemic mixtures" must be changed to or all pharmacologically acceptable salts, esters, stereoisomers or ~~racemic~~ racemic mixtures. The term "esters" and the expression "together comprise" render the claims indefinite by placing no definite limits or boundaries on the claims. The use of the open-ended term "comprises" is not permissible in the claiming of chemical compounds. The term "ester" is not limited to carboxylic acids but includes among others sulfuric, phosphonic boronic and arsenic acids which applicants do not mean or intend.

Claims 1 to 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokyo (WO 94-07866 or Orion (WO-97-12874 or Zhang et al, of record, for the reason as given in the last Office action.

Applicants must agree with the rejection to Zhang et al since no arguments were presented as to why the claimed subject matter is patentable over this reference. NO ^{has been forthcoming} showing of any in obvious properties. The references relied on disclose compounds which are so structurally similar to the claimed compounds as to be structurally similar with the expectation that these structurally obvious compounds would have the same or essentially the same properties. To be a viable reference the reference has to disclose structurally similar compounds which would render the claimed compounds structurally obvious and have a viable utility – this utility does not have to be the same utility

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applicants disclose for the claimed compounds. Again no showing of any unobvious or unexpected properties has, as of yet, been forth coming.

No clam is allowed.

Any inquiry concerning this communication should be directed to Floyd D Higel at telephone number 308-4530.

Higel/LR

February 5, 2002


FLOYD D. HIGEL
PATENT PRIMARY EXAMINEE
ART UNIT 123/626